United States Patent and Trademark Office

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,604	03/01/2002	Steve Bakke	021241.000006	1958

4095   7590   06/16/2005

VINSON & ELKINS. L.L.P.
1001 FANNIN STREET
2300 FIRST CITY TOWER
HOUSTON, TX 77002-6760

EXAMINER
SHIFERAW, ELENI A

ART UNIT	PAPER NUMBER
2136	

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/086,604	BAKKE, STEVE
	Examiner	Art Unit	
	Eleni A. Shiferaw	2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>01/03/2002</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-26</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-26</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>3/1/2002</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 1-26 are presented for examination.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3.   Claims 20-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. It is not tangibly embodied as it is only software per se. It is suggested that the claimed subject matter "a computer program product…" should be changed to "A program/instruction stored on a computer-readable medium …"

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gbadegesin (Pub. No.: US 2004/0210674 A1) in view of Schuster et al. (Schuster, US 6,822,957 B1).

As per claims 1, 8, 20, and 26, Gbadegesin teaches a method/computer program product of

providing communication between a provider endpoint at a provider location and a user endpoint

at a user location, the method comprising the steps of:

receiving a connection signal from a soft switch at the provider location, wherein a data

portion of the connection signal includes a private connection address associated with the

provider endpoint (page 1 par. 0004 lines 1-7, and par. 0008 lines 10-12);

storing the private connection address (page 4 par. 0042 lines 1-2);

modifying the connection signal by substituting a public connection address for the

private connection address (page 8 claim 8, and page 4 par. 0038 lines 1-5);

opening a communication port to provide communications between the user endpoint and

the provider endpoint (page 4 par. 0040 lines 4-10, and page 6 par. 0055 lines 6-12); and

sending the modified connection signal to the user endpoint (page 6 par. 0055 lines 6-12).

Gbadegesin does not explicitly teach the communication is a voice communication.

However Schuster teaches opening a voice communication port to provide

communications between the user endpoint and the provider endpoint (col. 6 lines 46-50, and

col. 8 lines 43-67). Therefore it would have been obvious to one having ordinary skill in the art

at the time of the invention was made to employ the teachings of Schuster within the system of

Gbadegesin because they are analogous in modifying a private address of a LAN device in order

to create a session to external network devices (col. 6 lines 18-23). One would have been

motivated to incorporate the teachings of Schuster within Gbadegesin because it would transmit

ordinary telephone calls over the internet using packetlinked routers, would allow a local

network to efficiently switch between external/internet network service providers, and provide

cost savings on the local network (col. 24 lines 4-27).

As per claim 14, Gbadegesin teaches a voice firewall comprising:

> a command input port (page 5 par. 0044-0045);

> a command output port (page 5 par. 0044-0045);

> a processor electrically connected to the command input port and the command output

port, wherein the processor is configured to receive a connection signal through the command

input port (page 1 par. 0008 lines 10-12), wherein the processor is further configured to

substitute a public connection address for a private connection address embedded within a data

portion of the connection signal (page 8 claim 8, and page 4 par. 0038 lines 1-5); and

> Gbadegesin fails to explicitly teach a voice communication.

> However Schuster teaches a voice communication port electrically connected to the

processor, wherein the voice communication port is associated with the private connection

address on a private side of the voice firewall and is associated with the public connection

address on a public side of the voice firewall (col. 5 lines 15-54, and fig. 1). Therefore it would

have been obvious to one having ordinary skill in the art at the time of the invention was made to

employ the teachings of Schuster within the system of Gbadegesin because they are analogous in

modifying a private address of a LAN device in order to create a session to external network

devices (col. 6 lines 18-23). One would have been motivated to incorporate the teachings of

Schuster within Gbadegesin because it would transmit ordinary telephone calls over the internet

using packetlinked routers, would allow a local network to efficiently switch between external/internet network service providers, and provide cost savings on the local network (col. 24 lines 4-27).

As per claims 2 and 22, Gbadegesin and Schuster teach all the subject matter as described above. In addition Schuster teaches the method/computer program product further comprising the step of opening a voice communication port, wherein the voice communication port provides a voice line between the user endpoint and the provider endpoint (col. 6 lines 46-50, and col. 8 lines 43-67). The rational for combining are the same as claim 1 above.

As per claims 3 and 9, Gbadegesin and Schuster teach all the subject matter as described above. In addition Schuster teaches the method/voice firewall further comprising the step of opening a voice communication port, wherein the voice communication port is configured to receive signals from the user endpoint at the public connection address and is configured to receive signals from the provider endpoint at the private connection address (col. 6 lines 46-50, and col. 8 lines 43-67). The rational for combining are the same as claim 1 above.

As per claims 4, 10, and 23, Gbadegesin and Schuster teach all the subject matter as described above. In addition Schuster teaches the method/computer program product, wherein the user endpoint is an IP telephone (fig. 1 No. 22). The rational for combining are the same as claim 1 above.

As per claims 5 and 11, Gbadegesin and Schuster teach all the subject matter as described above. In addition Schuster teaches the method, wherein the IP telephone is behind a conventional firewall (fig. 1 No. 22, and 39). The rational for combining are the same as claim 1 above.

As per claims 6, 12, and 24, Gbadegesin and Schuster teach all the subject matter as described above. In addition Schuster teaches the method/computer program product, wherein the provider endpoint is a gateway connected to a public switched telephone network (col. 5 lines 40-44, and fig. 1 No. 22, 39, and 32). The rational for combining are the same as claim 1 above.

As per claims 7, 13, and 25, Gbadegesin and Schuster teach all the subject matter as described above. In addition Schuster teaches the method/computer program product, wherein the provider endpoint is an IP telephone (fig. 1 No. 39). The rational for combining are the same as claim 1 above.

As per claim 15, Gbadegesin and Schuster teach all the subject matter as described above. In addition Schuster teaches the voice firewall, wherein the voice communication port is opened by the processor after receipt of the connection signal (col. 6 lines 46-50, and col. 8 lines 43-67). The rational for combining are the same as claim 1 above.

As per claim 16, Gbadegesin and Schuster teach all the subject matter as described above. In addition Schuster teaches the voice firewall, wherein the command input port and the command output port provide a conduit through the voice firewall for a command session between a soft

switch at a provider location and a user endpoint at a user location (col. 6 lines 46-50, and col. 8 lines 43-67). The rational for combining are the same as claim 1 above.

As per claim 17, Gbadegesin and Schuster teach all the subject matter as described above. In addition Schuster teaches the voice firewall, wherein:

the command input port and the command output port provide a conduit through the voice firewall for a command session between a soft switch at a provider location and a user endpoint at a user location (col. 6 lines 46-50, and col. 8 lines 43-67); and

the processor authenticates signals from user endpoint prior to initiation of the command session (fig. 4 No. 80, and col. 12 lines 49-col. 13 lines 26). The rational for combining are the same as claim 1 above.

As per claim 18, Gbadegesin and Schuster teach all the subject matter as described above. In addition Schuster teaches the voice firewall, wherein the processor provides firewall security for devices at a provider location by hiding the private addresses of the devices (page 8 claim 8, and page 4 par. 0038 lines 1-5). The rational for combining are the same as claim 1 above.

As per claim 19, Gbadegesin and Schuster teach all the subject matter as described above. In addition Schuster teaches the voice firewall, wherein:

the processor is electrically connected to a provider location on the private side of the voice firewall and is electrically connected to a user location on the public side of the voice firewall (col. 5 lines 15-54, and fig. 1); and

the processor facilitates communication between a user endpoint at the user location and

a provider endpoint at the provider location (col. 8 lines 43-67). The rational for combining are

the same as claim 1 above.

As per claim 21, Gbadegesin and Schuster teach all the subject matter as described above. In

addition Gbadegesin teaches the computer program product further comprising instructions for

storing the private connection address (page 4 par. 0042 lines 1-2).

6.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Eleni A. Shiferaw whose telephone number is 571-272-3867.

The examiner can normally be reached on Mon-Fri 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Eleni Shiferaw
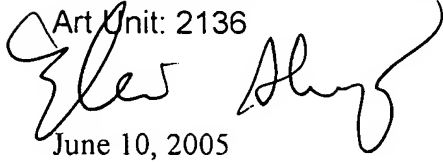
Art Unit: 2136

June 10, 2005